

Remarks

Claims 2-6 and 9-11 are pending.

By the above amendment, the claims withdrawn from consideration have been canceled without prejudice to the right to pursue them in one or more divisional applications. Claim 10 has been amended to more particularly define the protein, as supported in the original disclosure, e.g., by Figure 2 and claim 6. Dependent claim 11 has been amended so that it is directed to a method for identifying inhibitors, as supported in the specification, e.g., by Example 9 at page 49.

In the outstanding Office Action, the Examiner imposed a restriction requirement between each of the following groups of invention: (I) claims 1-5 and 9; (II) claims 6, 10, and 11; (III) claims 7 and 8; and (IV) claims 12 and 13. The undersigned affirms the election of Group II, claims 6, 10, and 11. This election is without traverse insofar as the various groups of invention are directed to patentably distinct subject matter and the Examiner has rejoined Group I with Group II.

With respect to the claims examined on their merits--claims 1-6 and 9-11--the Examiner indicated that they are all directed to subject matter patentable over the prior art of record. The Examiner is respectfully requested to initial the citations on the Form PTO-1449 submitted with the Supplemental Information Disclosure Statement dated October 30, 2003, to confirm patentability over the references cited therein.

Applicant acknowledges with appreciation the Examiner's allowance of claims 1-6 and 9. Applicant respectfully submits that claims 10 and 11, as presently amended, are also allowable for reasons explained below.

The Examiner rejected original claims 10 and 11 under 35 U.S.C. § 112, first paragraph, as containing subject matter not described in the specification as reasonably conveying possession of the claimed subject matter. The rejection of original claim 10 appears to be grounded on the lack of a sequence definition for the cathepsin S protein. Since independent claim 10 has been amended to expressly define the sequence for the monkey cathepsin S protein, there should be no question that the claimed invention is now defined with particularity and is supported by an adequate written description.


The rejection of original claim 11 appears to be grounded on the inclusion of enhancing cysteine protease activity as an alternative species of the modulatory effect being assayed. Even though claim 11 is now limited to methods for identifying inhibitors of monkey cathepsin S, there should be no question that claim 10, which generically covers methods for assaying for other types of modulators by measuring an effect of the compound on protease activity of the protein, is also supported by an adequate written description. As the Examiner acknowledged in citing Fiers v. Revel, 984 F.2d 1164, 25 U.S.P.Q.2d 1601 (Fed. Cir. 1993), that the specification does not exemplify every embodiment encompassed by a claim does not *ipso facto* establish that the specification fails to provide an adequate written description. Applicant respectfully submits that, in light of the ample description relating to methods for identifying modulators within the

scope of claims 10 and 11, the specification demonstrates possession of the claimed subject matter. Accordingly, the rejection under Section 112, paragraph one, should be withdrawn.

In view of the foregoing, the pending claims are allowable. Applicant therefore requests prompt and favorable action.

Respectfully submitted,

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Linda S. Evans  
Reg. No. 33,873

Johnson & Johnson  
One Johnson & Johnson Plaza  
New Brunswick, New Jersey 08933-7003  
(858) 320-3406